REMARKS

Claims 43, 44, 52, and 55 have been cancelled without prejudice or disclaimer. The specification and claims 35 and 51 have been amended. The amendment to the specification merely recites priority information and adds no new matter.

Claim 35 was amended to change the term "immunoassay" to the term "detection or determination." That new term is found in line 1 of claim 35. Claim 35 was also amended to include language from originally filed claims 43 and 44. Other changes were also made to claim 35. The amendments to claim 35 add no new matter.

Claim 51 has been amended to replace the word "absorption" with "adsorption". That change was made so that the claim corresponds to language in claim 35. Claim 51 was also amended to include language from originally filed claims 52 and 55. Other changes were also made to claim 51. The amendments to claim 51 add no new matter.

Claims 35 to 42, 45 to 51, 53, 54, 56, and 57 are under consideration in the application.

Oath

The Examiner contends that the oath/declaration is defective under 37 C.F.R. § 1.175. See Action, pages 2 to 3, items 3 to 4. Specifically, the Examiner alleges that the signing date of 1996 renders the oath defective. See Action, page 2, item 3.

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Applicants request that the Examiner hold this requirement in abeyance. Applicants will submit a supplemental reissue oath.

Rejection Under 35 U.S.C. § 251

The Examiner rejects claims 35 to 57 under 35 U.S.C. § 251 as allegedly "being an improper recapture of broadened subject matter surrendered in the application for the patent upon which the present reissue is based." See Action, pages 3 to 4, item 7. The Examiner then states that a "broadening aspect" is present in this reissue that was absent in the application for patent. See *Id.* But, the Examiner does not identify an alleged broadening aspect in the reissue claims. Applicants respectfully traverse this rejection.

The Examiner bears the burden of establishing why recapture exists. Here, the Examiner fails to identify the alleged omitted or broadened claim limitations. See MPEP § 1412.02. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejection under § 251.

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Certificate of Correction

The Examiner notes that the corrections listed in the certificate of correction have not been inserted into the claims of this reissue. See Action at page 4, item 9. Applicants submit a new copy of the patent with the corrections inserted into the claims.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claim 44 under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. See Action at page 4, item 10. Specifically, the Examiner notes that the term "chromathographic" is misspelled. See Action at page 5, item 10. Applicants cancelled claim 44. Thus, the § 112, second paragraph, rejection is moot.

Rejections Under 35 U.S.C. § 102(b)

The Examiner rejects claims 35, 38, 43 to 45, and 48 to 50 under 35 U.S.C. § 102(b) as allegedly being anticipated by Deutsch. See Action at page 5, item 12. Applicants respectfully traverse.

To find anticipation, the Examiner must establish that the prior art document contains all of the elements of the claimed invention. See MPEP § 2131. Each and every claim element must be expressly or inherently described in a single prior art

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reference. See MPEP § 2131. Here, the Examiner fails to establish that Deutsch contains every element of the rejected claims.

First, Applicants have amended claim 35 to include language from dependent claims 43 and 44. Although the Examiner rejects claims 43 and 44 as allegedly being anticipated by Deutsch, the Examiner fails to explain how the elements of those two claims are shown by Deutsch. Therefore, for at least this reason, the Examiner fails to establish that Deutsch shows every element of amended claim 35.

Moreover, Applicants assert that Deutsch does not show all of the elements of amended claim 35. Amended claim 35 recites a mobile phase application zone that has dimensions to contain sufficient fluid to permit the fluid to migrate to the adsorption zone. Deutsch recites no similar element. In fact, Deutsch describes immersing the end of the strip in a precise volume of developing fluid, "thereby resulting in the automatic termination of the transport of the developing fluid at the proper time." Deutsch at column 4, lines 27-34. Thus, unlike the device of claim 35, the Deutsch device must be immersed in a precise volume of developing fluid in order to advance the fluid to terminal end portion 16. Consequently, for this additional reason, Deutsch does not contain all of the elements of amended claim 35.

Accordingly, the Examiner fails to establish that Deutsch anticipates amended claim 35 under § 102(b). Claims 38, 45, and 48-50 all depend from claim 35. Thus, for at least the reasons discussed above for claim 35, the Examiner fails to establish that Deutsch anticipates those dependent claims under § 102(b). Moreover, the Examiner fails to explain how Deutsch shows additional elements recited in dependent claims 45,

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49 and 50. For this additional reason, the Examiner fails to establish that Deutsch anticipates those dependent claims under § 102(b).

Because the Examiner fails to establish anticipation of claims 35, 38, 45, and 48 to 50 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection in view of Deutsch.

The Examiner rejects claims 35, 43 to 45, 48 and 49 under 35 U.S.C. § 102(b) as allegedly being anticipated by Count 2 from the interference proceedings. See Action at page 7, item 13. Applicants respectfully traverse this rejection.

To find anticipation, the Examiner must establish that the prior art document contains all of the elements of the claimed invention. See MPEP § 2131. The Examiner fails to establish that Count 2 shows all of the elements of claim 35. Specifically, although the Examiner rejects claims 43 and 44 as allegedly being anticipated by Count 2, the Examiner fails to explain how the elements of those two claims are shown by Count 2. As discussed above, claim 35 now includes those elements. Consequently, for at least this reason, Count 2 does not show all of the elements of claim 35.

Moreover, Applicants assert that Count 2 does not contain all of the elements of amended claim 35. Amended claim 35 recites a mobile phase application zone that has

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dimensions to contain sufficient fluid to permit the fluid to migrate to the adsorption zone. Count 2 contains no similar element. Count 2 simply recites a mobile phase application zone. Therefore, for this additional reason, Count 2 does not contain all of the elements of amended claim 35.

Accordingly, the Examiner fails to establish that Count 2 anticipates claim 35 under § 102(b). Claims 45, 48, and 49 all depend from claim 35. Thus, for at least the reasons discussed above for claim 35, the Examiner fails to establish that Count 2 anticipates those dependent claims under § 102(b). Moreover, the Examiner fails to explain how Count 2 shows additional elements recited in dependent claims 45 and 49. For this additional reason, the Examiner fails to establish that Count 2 anticipates those dependent claims under § 102(b).

Because the Examiner fails to establish anticipation of claims 35, 45, 48, and 49 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection in view of Count 2.

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Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects claims 35, 36, 38, 40, 42 to 45, and 48 to 50 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 1 from the interference proceedings in view of Deutsch, or Weng, or Giegel, or Rupchock. See Action at page 8, item 15. Applicants respectfully traverse this rejection.

At the outset, Applicants assert that Weng is not prior art. Applicants claim a priority date under 35 U.S.C. § 119 of December 15, 1984 in view of German Patent Application No. P 34 45 816.6. Applicants made this claim in section 12 of the Divisional Application Request Under 37 C.F.R. § 1.53(b), which was filed in this application on March 30, 2001. A verified translation of German Patent Application No. P 34 45 816.6 is on record in U.S. Patent No. 4,861,711. The verified translation was filed December 21, 1992. A copy of the verified translation is enclosed. Also Applicants were provided the benefit of that filing date in Interference No. 103,072. A copy of the ruling granting the benefit of that filing date is enclosed. Therefore, Applicants are entitled to a December 15, 1984 priority date. Weng filed their application on February 14, 1985. Therefore, Weng is not prior art. This applies for each rejection in which the Examiner cites Weng.

For a proper obviousness rejection, the Examiner must establish that the prior art would have suggested to one of ordinary skill all of the claim limitations. See MPEP § 2143.03. Although the Examiner rejects claims 43 and 44 under § 103, the Examiner fails to address additional elements in those two claims. As discussed above, claim 35

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now includes those elements. Consequently, the Examiner fails to establish that the cited references would have suggested all of the elements of claim 35.

Moreover, Applicants assert that the references do not suggest all of the claim elements. Amended claim 35 recites a mobile phase application zone that has dimensions to contain sufficient fluid to permit the fluid to migrate to the adsorption zone. Amended claim 35 also recites a layer of substantially planar zones containing at least two sheet-like strips made from different materials. As discussed above, amended claim 35 does not require that the device be immersed in a precise volume of developing fluid to advance the fluid to the adsorption zone. In fact, in certain embodiments of the device of claim 35, it is not necessary to use a separate developing fluid from the fluid sample. Also, in certain embodiments in the device of amended claim 35, one may employ at least two sheet-like strips made from different materials with different liquid flow properties. The Examiner has not explained how the cited documents would have suggested such features.

For at least these reasons, the Examiner fails to establish a *prima facie* case of obviousness of claim 35. Claims 36, 38, 40, 42, 45, and 48 to 50 all depend from claim 35. Thus, for at least the reasons discussed above for claim 35, the Examiner fails to establish a *prima facie* case of obviousness for those dependent claims. Moreover, the Examiner fails to address the additional elements of dependent claims 45, 49 and 50. For this additional reason, the Examiner fails to establish a case of *prima facie* obviousness of those dependent claims.

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Because the Examiner fails to establish obviousness of claims 35, 38, 40, 42, 45, and 48 to 50 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 1 and Deutsch, Weng, Giegel, or Rupchock.

The Examiner rejects claims 41, 46 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 1 from the interference proceedings in view of Deutsch, or Weng, or Giegel, or Rupchock as applied to claims 35, 36, 38, 40, 42-45, and 48-50, and further in view of Kondo. See Action at page 12, item 16. Applicants respectfully traverse.

First, as discussed above, Applicants assert that Weng is not prior art. Accordingly, the rejection applying Weng should be withdrawn.

Second, Applicants assert that, in view of the argument above, the Examiner fails to establish that the combination of Count 1 and Deutsch, Weng, Giegel, or Rupchock would have rendered claim 35 obvious. Claims 41, 46, and 47 all depend from claim 35. Thus, for at least the reasons discussed above for claim 35, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims. Moreover, the Examiner fails to address the additional elements of claim 46. For this additional reason, the Examiner fails to establish a *prima facie* case of obviousness for that dependent claim.

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Because the Examiner fails to establish obviousness of claims 41, 46, and 47 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 1 and Deutsch, Weng, Giegel, or Rupchock, in view of Kondo.

The Examiner rejects claims 51 to 57 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 1 from the interference proceedings in view of Kondo. See Action at page 13, item 17. Applicants respectfully traverse.

Applicants have amended claim 51 to include language from dependent claims 52 and 55. Although the Examiner rejects claims 52 and 55, the Examiner fails to address additional elements in those two claims. Consequently, the Examiner fails to address all of the elements of amended claim 51.

Moreover, Applicants assert that the references do not suggest all of the claim elements. Amended claim 51 recites a mobile phase application zone that has dimensions to contain sufficient fluid to permit the fluid to migrate to the adsorption zone. Amended claim 51 also recites a layer of substantially planar zones containing at least two sheet-like strips made from different materials. As discussed above, amended claim 51 does not require that the device be immersed in a precise volume of developing fluid to advance the fluid to the adsorption zone. In fact, in certain embodiments of the device of claim 51, it is not necessary to use a separate developing

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fluid from the fluid sample. Also, in certain embodiments in the device of amended claim 51, one may employ at least two sheet-like strips made from different materials with different liquid flow properties. The Examiner has not explained how the cited documents would have suggested such features.

For at least these reasons, the Examiner fails to establish a *prima facie* case of obviousness of claim 51. Claims 53, 54, 56, and 57 all depend from claim 51. Thus, for at least the reasons discussed above for claim 51, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims. Moreover, the Examiner fails to address the additional elements of dependent claims 53, 56, and 57. For this additional reason, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims.

Because the Examiner fails to establish obviousness of claims 51, 53, 54, 56, and 57 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 1 in view of Kondo.

The Examiner rejects Claims 36, 37, 39-42, 46, 47, 51-54, 56, and 57 under 35 U.S.C. § 103(a) as allegedly being obvious over Deutsch, in view of Kondo and Tom. See Action at page 14, item 18. Applicants respectfully traverse.

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Applicants will first discuss the rejected claims that depend from claim 35. Then Applicants will discuss independent claim 51 and the rejected claims that depend from claim 51.

First, claims 36, 37, 39 to 42, 46 and 47 all depend from claim 35. As discussed above, claim 35 has been amended to include language from claims 43 and 44. Claims 43 and 44 are not rejected in this rejection. Thus, the rejection of dependent claims 36, 37, 39 to 42, 46, and 47 is moot.

Because the rejection of claims 36, 37, 39 to 42, 46 and 47 is moot, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Second, independent claim 51 has been amended to include language from claim 55. Claim 55 is not rejected in this rejection. Thus, the rejection of claim 51 is moot. Claims 53, 54, 56, and 57 all depend from claim 51. Thus, for the reasons discussed above for claim 51, the rejection of those dependent claims is moot.

Because the rejection of claims 51, 53, 54, 56, and 57 is moot for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Deutsch in view of Kondo and Tom.

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The Examiner rejects claims 37 and 39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 1 from the interference proceedings in view of Deutsch, or Weng, or Giegel, or Rupchock, as applied to claims 35, 36, 38, 40, 42 to 45, and 48 to 50, and further in view of Tom. See Action at page 15, item 19. Applicants respectfully traverse.

First, as discussed above, Applicants assert that Weng is not prior art. Accordingly, the rejection applying Weng should be withdrawn.

Second, Applicants assert that, in view of the argument above, the Examiner fails to establish that the combination of Count 1 and Deutsch, Weng, Giegel, or Rupchock would have rendered claim 35 obvious. Claims 37 and 39 both depend from claim 35. Thus, for at least the reasons discussed above for claim 35, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims.

Because the Examiner fails to establish obviousness of claims 37 and 39 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 1 and Deutsch, Weng, Giegel, or Rupchock, in view of Tom.

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The Examiner rejects claims 36, 40, 41, 42, 46, 47, and 51-57 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 2 from the interference proceedings in view of Kondo. See Action at page 15, item 20. Applicants respectfully traverse.

Applicants will first discuss the rejected claims that depend from claim 35. Then Applicants will discuss independent claim 51 and the rejected claims that depend from claim 51.

First, claims 36, 40 to 42, 46 and 47 all depend from claim 35. As discussed above, claim 35 has been amended to include language from claims 43 and 44. Claims 43 and 44 are not rejected in this rejection. Thus, the rejection of dependent claims 36, 40 to 42, 46 and 47 is moot.

Because the rejection of claims 36, 40 to 42, 46 and 47 is moot for the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Second, Applicants have amended claim 51 to include language from dependent claims 52 and 55. Although the Examiner rejects claims 52 and 55, the Examiner fails to address additional elements in those two claims. Consequently, the Examiner fails to address all of the elements of amended claim 51.

For at least this reason, the Examiner fails to establish a *prima facie* case of obviousness of claim 51. Claims 53, 54, 56, and 57 all depend from claim 51. Thus, for

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at least the reasons discussed above for claim 51, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims. Moreover, the Examiner fails to address the additional elements of dependent claims 53, 56, and 57. For this additional reason, the Examiner fails to establish a *prima facie* case of obviousness of those dependent claims.

Because the Examiner fails to establish obviousness of claims 51, 53, 54, 56, and 57 for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 2 and Kondo.

The Examiner rejects claims 37 to 39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Count 2 from the interference proceedings in view of Tom. See Action at page 16, item 21. Applicants respectfully traverse.

First, claims 37 to 39 all depend from claim 35. As discussed above, claim 35 has been amended to include language from claims 43 and 44. Claims 43 and 44 are not rejected in this rejection. Thus, the rejection of dependent claims 37 to 39 is moot.

Because the rejection of claims 37 to 39 is moot for at least the reasons discussed above, Applicants need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, Applicants in no way acquiesce to those contentions.

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Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Count 2 and Tom.

CONCLUSION

Applicants assert that pending claims 35 to 42, 45 to 51, 53, 54, 56 and 57 are allowable and request a timely issuance of a Notice of Allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: December 20, 2002

By: _____

M. Paul Barker
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